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EXAMINER
[illegible]INHARDT,R

ART UNIT	PAPER NUMBER
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DATE MAILED: 04/22/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 3-29-94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ______ ~~days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ ______________________.

Part II SUMMARY OF ACTION

1. ☒ Claims 14-24, 26-29, 33-34, 38-39, 66-76, 78-81, 85-86 AND 90-91 are pending in the application.

   Of the above, claims ______________________ are withdrawn from consideration.

2. ☒ Claims 1-13, 25, 30-32, 35-37, 40-65, 77, 82-84, 87-89 AND 92-117 have been cancelled.
3. ☐ Claims ______________________ are allowed.
4. ☒ Claims 14-24, 26-29, 33-34, 38-39, 66-76, 78-81, 85-86 AND 90-91 are rejected.
5. ☐ Claims ______________________ are objected to.
6. ☐ Claims ______________________ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on ______________. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on __________. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed __________, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. __________ ; filed on __________.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. The preliminary amendments filed 7/28/94 have been entered.

2. Claims 14-24, 26-29, 33-34, 118-133 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,237,157. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons set forth below.

The patented claims recite a method for previewing information from a music product for sale including entering a subscriber code at a kiosk, identifying the music product (including the use of a bar code reader) by supplying a product code from the music product's packaging, and interactively reproducing portions of the product. While the instant claims do not recite the source of the identification of the music product to the kiosk, deletion thereof, with the corresponding loss of function would have been obvious to those of ordinary skill in the art. With regard to the recitations in the instant claims concerning the collection of frequency data, note the recitations of gathering market research data in patented claim 11. While patented claim 11 also includes recitations of gathering demographic information, again, the deletion of this feature with the corresponding loss of function would have been obvious to those of ordinary skill in the art.

3. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 14-17, 22-23, 26 and 33 are rejected under 35 U.S.C. § 103 as being unpatentable over Riddell et al. (GB 2,218,081) in view of Bradt et al. and Stern et al.

Riddell et al. teach a dispensing machine for selling at least audio cassettes or compact discs including means to reproduce extracts of the information

contained therein for a user in order to preview the product. Riddell further teaches that the user enters a code to identify the product to which the machine responds by reproducing the extracts. Since the code is not recited in the instant claims as being read or transferred from the actual packaging of the specific product selected, merely entering the code as described in Riddell meets the claimed limitation. Further, although the claims do not call for vending the product, this is not excluded by the claims. See the entire document of Riddell.

While Riddell does not specifically teach identification means to identify the user to the system for access purposes, Riddell does teach that the dispensing machine can use debit or credit cards in order to sell the product to the user, which would necessarily identify and authorize the user. Although Riddell does not specifically teach that reading the credit or debit card occurs prior to previewing, Bradt et al. teaches a vending machine for video tapes or music disks that includes a preview option wherein user verification is performed prior to other operations including preview. See fig. 9 of Bradt. This prior verification provides the obvious advantage of limiting access to the machine to those that can actually complete a transaction on the machine so that it is not tied up providing previews or other functions when a profit cannot be made.

Finally, although Riddell and Bradt fail to specifically teach enabling the user to choose among selections from the music product identified, Stern teaches with

regard to an music previewing system, the benefit of allowing the user to associate particular desired music selections with a particular music product. Considering that artists, recording labels, etc. are well known to release a plurality of "singles" from one album or product and considering the above mentioned desire to associate particular music selections with a particular product taught by Stern, it would have been obvious to those of ordinary skill in the art to modify the teachings of Riddell to include means allowing the user to choose among plural selections on the product to increase the ability of the user to associate particular selections with a particular product. See the abstract and background of the invention of Stern.

6. Claims 118-120, 125-128 and 133 are rejected under 35 U.S.C. § 103 as being unpatentable over Baus in view of Stern et al.

Baus teach an apparatus for retrieving stored information about various products in response to reading the bar code on the product in order to provide the customer with the information desired to make a purchase. The apparatus of Baus includes audio and video output from an optical disc device to present the information to the user. While Baus does not specifically teach that the apparatus provides information on music products including previews from the product, Baus

does teach that the apparatus is for use in department stores and the like, which are well known to sell music products. See the entire document of Baus.

Further, as mentioned above, Stern et al. teaches the desirability of associating a particular music selection with a particular music product to help a customer purchase a product in a music preview system that provides information to customers so as to assist them in their purchasing process. Also, Stern teaches that the information provide to the user is a preview of a portion of the product, which obviously is the customer's concern when attempting to purchase a music product. Considering the suggestion of Baus concerning department stores and considering the known desirability of associating music selections with music products, it would have been obvious to those of ordinary skill in the art to modify the teachings of Baus to include music previews as taught by Stern in the apparatus of Baus to provide the obvious advantage of assisting a customer in purchasing music products.

Finally, although Baus fails to specifically teach enabling the user to choose among selections from the music product identified, as mentioned above, Stern teaches with regard to an music previewing system, the benefit of allowing the user to associate particular desired music selections with a particular music product. Considering that artists, recording labels, etc. are well known to release a plurality of "singles" from one album or product and considering the above

mentioned desire to associate particular music selections with a particular product taught by Stern, it would have been obvious to those of ordinary skill in the art to modify the teachings of Baus to include means allowing the user to choose among plural selections on the product to increase the ability of the user to associate particular selections with a particular product. See the abstract and background of the invention of Stern.

7. Claims 18-21, 27-29, 121-124 and 129-132 are rejected under 35 U.S.C. § 103 as being unpatentable over Riddell et al. in view of Bradt et al. and Stern et al. as applied to claims 14-17, 22-23, 26 and 33 above and further in view of Hughes (for claims 18-21, 27-29), or Baus in view of Stern et al. as applied to claims 118-120, 125-128 and 133 above and further in view of Hughes (for claims 121-124, 129-132).

Riddell, Bradt, Baus and Stern fail to specifically teach the gathering of frequency data concerning the selections. Hughes, however, teaches the collection of frequency information regarding selections from a music reproducing device which provides the obvious advantage of informing the business employing the system of the popular selections. See the abstract of Hughes. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of

Riddell or Baus to include the collection of frequency information as taught by Hughes so as to identify popularity trends in selections and hence increase sales.

8. Claims 24 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims upon resolution of the obvious-type double patenting issue.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached on (703) 305-9711. Facsimile transmissions to this Group may be directed to (703) 305-9564 or 9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

September 24, 1994

ROBERT A. WEINHARDT
PRIMARY EXAMINER
GROUP 2300